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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte YOSHIHARU KURODA and TAKASHI YAMAGATA

Appeal No. 2002-0188
Application No. 08/942,415

HEARD: January 21, 2003

Before HAIRSTON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 13, which are all of the claims pending in this application.

Appellants' invention relates to an image recording device with both facsimile and copier functions and provided with an image scanning part and recording part. The image recording device includes a recorded paper discharge tray, a document sheet supply tray, a document sheet outlet tray, and a multi-purpose tray all confined within the width of the device. Claim 6 is illustrative of the claimed invention, and it reads as follows:

6. An image recording device having a top, a bottom and a width, comprising:

a main body including:

a recorded paper discharge tray provided at the top of the image recording device;

a document sheet supply tray provided below the recorded paper discharge [sic, tray] for holding a document sheet;

a document sheet outlet tray provided below the document sheet supply tray for receiving the document sheet;

a base having an exposed upper surface; and

a multi-purpose tray provided on said exposed upper surface of said base and below the document sheet outlet tray for holding at least one recording sheet and supplying a recording sheet one page at a time;

an image scanner that transports the document sheet from the document sheet supply tray, scans an image on the document sheet and discharges the document sheet onto the document sheet outlet tray; and

a recording part that transports the recording sheet form [sic, from] the multi-purpose tray, recording [sic, records] an image on the recording sheet and discharges the recording [sic, sheet onto the recorded paper discharge tray, with the recorded] paper discharge tray, the document sheet supply tray, the document sheet outlet tray and the multi-purpose tray being confined within the width of the image recording device.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kitazawa	5,078,380	Jan. 07, 1992
Kojima et al. (Kojima)	5,412,490	May 02, 1995
Ono	5,796,496	Aug. 18, 1998 (filed Sep. 22, 1994)
Sakaue et al. (Sakaue)	EP 0673147	Sep. 20, 1995

Claims 1 through 3, 6 through 8, 11, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kojima in view of Ono and Kitazawa.

Claims 4, 5, 9, 10, and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kojima in view of Ono, Kitazawa, and Sakaue.

Reference is made to the Examiner's Answer (Paper No. 28, mailed August 15, 2001) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 27, filed July 31, 2001) and Reply Brief (Paper No. 30, filed October 15, 2001) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 13 and apply a new ground of rejection under 35 U.S.C. § 112, second paragraph, against claims 1 through 13.

The first step of an obviousness analysis under 35 U.S.C. § 103 is to determine the scope of the claims. ***See In re Hiniker Co.***, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). There is a heavy presumption that the terms in the claims, unless otherwise compelled, give full effect to the ordinary and

accustomed meaning of claim terms. ***See Johnson Worldwide Associates Inc. v. Zebco Corp.***, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

Independent claims 1 and 6 each recite, in pertinent part, "a base having an exposed upper surface" and "a multi-purpose tray provided on said exposed upper surface of said base." The preposition "on" is defined (***The Random House College Dictionary***, Revised Edition, Random House, 1982, p. 928) as "1. so as to be or remain supported by: *a book on a table; a hat on a hook*," "2. so as to be attached to or unified with: *a picture on a wall*," "3. so as to be a covering or wrapping for: *Put a blanket on the baby*," or "5. so as to have as a supporting part or base: *a painting on canvas*" (copy attached to this decision). In other words, the multi-purpose tray of claims 1 and 6 must be supported by or attached to the base, thereby covering the base. Thus, once the multi-purpose tray is provided on the upper surface, the surface is no longer exposed. Therefore, the claim recitation of a base with an exposed surface is confusing.

Furthermore, consistent with the language of the claims, appellants explain (specification, page 5) that "multi-purpose tray 6 . . . [is] positioned on the device main body 1" and (specification, page 8) that "multi-purpose tray 6 is formed on

the upper surface of the base." On the other hand, the specification discloses (page 4) that "[i]f the recording sheet supply unit is removed from the device, the multi-purpose tray defines the bottom of the image recording device" and (page 12) that "the multi-purpose tray 6 is a built-in tray" (underlining ours). None of the figures has a reference numeral for the base nor for the exposed surface thereof. Therefore, the claim recitation of a multi-purpose tray "on said exposed upper surface of said base" is unclear.

Appellants' arguments (Reply Brief, page 2) fail to clear up the confusion, as appellants state that "the user looking down at the multi-purpose tray 6 sees the exposed upper surface of the base 1. This is because the multi-purpose tray 6 is provided on or built-into the exposed upper surface of the base 1, as can be seen in Fig. 1" (underlining ours). Thus, as we are unable to determine what constitutes the base and its "exposed upper surface," we cannot determine the metes and bounds of claims 1 and 6 and their dependents, claims 2 through 5 and 7 through 13. We would have to resort to speculation and assumptions to apply prior art to the limitations of the claim. ***See In re Steele***, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). Accordingly, we reverse the obviousness rejection of claims 1 through 3, 6 through 8, 11, and 12 over Kojima, Ono, and Kitazawa and of

claims 4, 5, 9, 10, and 13 over Kojima, Ono, Kitazawa, and Sakaue.

REJECTION UNDER 37 C.F.R. § 1.196(b)

Pursuant to the provisions of 37 C.F.R. § 1.196(b), we hereby enter the following new ground of rejection:

Claims 1 through 13 are rejected under 35 U.S.C. § 112, second paragraph. As indicated **supra**, the claims are indefinite because it is unclear how the base can simultaneously have an exposed upper surface and also a multi-purpose tray "on the exposed upper surface." Furthermore, we cannot determine what in the disclosure corresponds to the base and to the exposed upper surface thereof nor the relative locations of the multi-purpose tray and the upper surface of the base.

CONCLUSION

The decision of the examiner rejecting claims 1 through 13 under 35 U.S.C. § 103 is reversed. In addition to reversing the examiner's rejection of claims 1 through 13, this decision contains a new ground of rejection of claims 1 through 13 under 35 U.S.C. § 112, second paragraph, pursuant to 37 C.F.R. § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides

that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 C.F.R. § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED
37 C.F.R. § 1.196(b)

KENNETH W. HAIRSTON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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